No. 94-1437

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

CONOPCO, INC. d/b/a CHESEBROUGH-POND'S USA CO.,
Petitioner,

v.

MAY DEPARTMENT STORES COMPANY, VENTURE STORES, INC.,
THE BENJAMIN ANSEHL COMPANY, and KESSLER CONTAINERS, LTD.,
Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

OBJECTION OF RESPONDENTS THE BENJAMIN ANSEHL COMPANY AND KESSLER CONTAINERS, LTD. TO THE MOTIONS FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

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Respondents The Benjamin Ansehl Company ("Ansehl") and Kessler Containers, Ltd. ("Kessler") respectfully request that this Court deny the Motions for Leave to File Brief *Amicus Curiae* in this matter. Five would-be friends of the Court, including three disappointed litigants who, like Conopco, Inc. ("Conopco"), failed to prove a likelihood of confusion as trade

dress plaintiffs[1], urge this Court to grant certiorari by conjuring up vague images of legal conflicts between the Federal Circuit's decision in this case and other decisions. None of their motions has merit or bears close scrutiny.

Ansehl and Kessler have withheld consent because the proposed Amici cannot and have not set forth any facts or questions of law which have not been adequately presented by the parties. Rather, these national brand manufacturers lend their support to Conopco, hoping the Court will be persuaded by their interest rather than by the merits of the Petition. Neither their repetition of Conopco's frivolous arguments nor their mischaracterization of the Federal Circuit's decision can create a conflict where none exists.

The proposed Amici seek review of this case to change established law requiring proof of likelihood of confusion in trade dress cases. The proposed Amici ask this Court to eliminate the need for proof of a likelihood of confusion and substitute

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[1] Bristol-Myers Squibb ("Bristol-Myers"), American Home Products Corporation and Nabisco, Inc. ("American Home Products") and SmithKline Beecham ("SmithKline") are each former unsuccessful plaintiffs in Lanham Act cases for the same reason as Conopco, i.e. they failed to establish a likelihood of confusion at trial. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1044-45 (2d Cir. 1992) (no likelihood of confusion between Bristol-Myers Squibb's "Excedrin PM" and "Tylenol PM"); *American Home Products Corp. v. Barr Laboratories, Inc.*, 656 F. Supp. 1058, 1067, 1070-71 (D.N.J. 1987), *aff'd*, 834 F.2d 368 (3d Cir. 1987) (no likelihood of confusion between American Home Products' "Advil" and the defendant's product despite intentional copying); *SmithKline Beckman Corp. v. Proctor & Gamble Co.*, 591 F. Supp. 1229, 1243 (D.N.Y. 1984), *aff'd*, 755 F.2d 914 (2d Cir. 1985) (no likelihood of confusion between SmithKline Beckman's "Ecotrin" trademark and the defendant's product considering the absence of actual confusion and the presence of the defendant's name and logo on its boxes). None thought their losses worthy of review by this Court at the time. No change in circumstances or the state of the law makes the "likelihood of confusion" issue worthy of review now.

proof of intentional copying. Intent has never been an element of trade dress infringement. Likelihood of confusion has always been an express requirement.

The proposed Amici rail at the Federal Circuit's decision saying that it authorizes retailers "to slavishly copy [national brand] trade dress." Bristol-Myers' Motion for Leave to File Brief at ii. As recently as its decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), this Court has recognized a defendant's right "to copy plaintiff's goods slavishly down to the minutest detail." *Id.* at 157. The only limitation on defendant's right to copy is the prohibition against *copying which tends to confuse.*

The proposed Amici add nothing of substance or relevance to this Court's consideration of Conopco's Petition. This Court should deny their Motions and Conopco's Petition. The Federal Circuit correctly recognized the law and the evidence which the District Court failed to consider. There is no conflict between the Circuits. The prominence of the Venture logo and the absence of confusion despite a long history of side-by-side competition should have been considered by the trial court. The trial court completely ignored salient evidence and Eighth Circuit law. Its finding of likelihood of confusion was clearly erroneous.

A. This Court should deny the Motions for Leave to File Brief *Amicus Curiae* because they offer no facts or questions of law which Conopco's Petition has not addressed.

Gerstman+Meyers, Inc., Wallace Church Associates, Inc. ("Gerstman+Meyers") and SmithKline add nothing new to this Court's consideration of the Petition. Content to rehash Conopco's arguments, they fail to offer any "facts or questions of law that have not been . . . presented by the parties" as required by Supreme Court Rule 37.4. Indeed, these proposed Amici make no attempt whatsoever to add substance to the Court's consider-

ation of the issues. This Court should deny their Motions since they rely only on the same mischaracterization of the Federal Circuit's decision and contrived "conflict" with the Second Circuit as Conopco.

B. There is no conflict between the Federal Circuit's decision and the decision of this Court in *Two Pesos*.

To attract this Court's attention, Bristol-Myers, American Home Products and the International Trademark Association ("INTA") suggest that the Federal Circuit's decision is somehow at odds with the decision in *Two Pesos, Inc. v. Taco Cabana, Inc.*, ___ U.S. ___, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992), *reh'g denied*, ___ U.S. ___, 112 S.Ct. 20 (1992) ("*Two Pesos*"). Respondents Ansehl and Kessler address each of their arguments separately as follows:

1. Bristol-Myers says that the Federal Circuit's decision ignores *Two Pesos* and "the critical importance trade dress plays in the selection of goods by consumers." Bristol-Myers' Motion for Leave to File Brief at ii. It never identifies any *holding* of the Federal Circuit that conflicts with the *Two Pesos* decision. It never identifies any *statement* of the Federal Circuit that conflicts with *Two Pesos*. It never says why *Two Pesos* is even relevant to consideration of the issues before the Federal Circuit.

Ansehl and Kessler agree with the general proposition for which *Two Pesos* is cited by Bristol-Myers, i.e. that trade dress is entitled to the same protection as trademarks under the Lanham Act. However, Bristol-Myers makes no attempt to demonstrate to this Court that the Federal Circuit's decision affords trade dress any less protection than trademarks.

In fact, there was no reason for the Federal Circuit to discuss or consider this Court's decision in *Two Pesos*. *Two Pesos* did not remotely address the standards for a finding of "likelihood of confusion" in trade dress cases. On the contrary, *Two Pesos* held

that a trade dress plaintiff could prove infringement by showing its trade dress was "inherently distinctive" without showing that it had acquired "secondary meaning." Clearly, there is no conflict between the *holdings* of the Federal Circuit and *Two Pesos*.

2. American Home Products also cites *Two Pesos* for the proposition that the Lanham Act protects trademarks and trade dress equally. American Home Products' Brief at 3-4. It also fails to say how the Federal Circuit's decision in any way treats trade dress differently than trademarks. Instead, it lists string citations for the proposition that courts have found a likelihood of confusion even though the defendant's trademark appeared somewhere on its product. American Home Products' Brief at 5 n.5.[2]

This argument misses the point. The Federal Circuit did not create a rule in this case that the presence of the defendant's trademark negates likelihood of confusion as a matter of law. Each such case must be decided on its facts. None of the factual circumstances of the cases cited by American Home Products resembles the factual context of this case. Nor did the Courts even decide the same issues. Indeed, American Home Products never really explains how the authorities upon which it relies are even marginally relevant to the issues before this Court.

3. INTA makes no pretense at identifying a real conflict between the Federal Circuit and the *Two Pesos* holdings but

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[2] In three of the cases American Home Products lists, the court found evidence of actual confusion. *AmBrit Inc. v. Kraft, Inc.*, 805 F.2d 974 (11th Cir. 1986), re-reported, 812 F.2d 1531, 1544 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987) (consumer testimony and survey evidence supported a finding of actual confusion); *Kraft General Foods, Inc. v. Friendship Dairies, Inc.*, 19 U.S.P.Q.2d 1691, 1694 (S.D.N.Y. 1991) (court found the confusion survey to be "convincing evidence" of actual confusion.); *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (court found actual confusion).

argues that the Federal Circuit failed to "follow [*Two Pesos*'] rationale." INTA's Brief at 5. It makes a stab at identifying a conflict with *Two Pesos*' "rationale" by saying that the Federal Circuit provides a lesser standard of protection for trade dress than trademarks. It does so by completely mischaracterizing the Federal Circuit's holding and decision in this case. INTA says the Federal Circuit held:

> the *mere presence of respondent's logo on respondent's private label imitation of petitioner's trade dress in and of itself* rendered clearly erroneous the district court's finding of likelihood of confusion . . . .

INTA's Brief at 5-6 (emphasis added). On the contrary, the Federal Circuit expressly held that the District Court's finding of a likelihood of confusion was "clearly erroneous" because the District Court failed to consider:

> [t]he unique and extensive appearance of [the Venture] logo in the store parking lot, on store signs, on employees' badges, in Venture's frequent and periodic print and television advertisements, and on other private label items sold by Venture, the large volume of Venture's annual sales ($1.3 billion in 1990), and the dearth of evidence that consumers ever purchased the Venture brand thinking it to have originated from Conopco despite the extended (over 10 year) period over which the original and relaunched products were sold alongside the Venture brand, give rise to the expectation that consumers . . . use [the Venture] logo to successfully distinguish between the two brands.

Conopco Inc., d/b/a Chesebrough-Pond's USA Co. v. May Department Stores Co., et al., ___ F.3d ___, 32 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1994) (footnotes omitted) (Reprinted in Conopco's Petition at Appendix A) ("*Pet.*" at 16a-17a).

INTA does not explain how this holding of the Federal Circuit conflicts with the "rationale" of *Two Pesos*. In fact, use of a

defendant's name and the absence of confusion negated "likelihood of confusion" in a trademark case involving SmithKline. *See SmithKline Beckman Corp. v. Proctor & Gamble Co.*, 591 F. Supp. 1229 (S.D.N.Y. 1984), *aff'd*, 755 F. 2d 914 (2d Cir. 1985)[3]. In other words, the factors which may negate "likelihood of confusion" in trade dress cases also negate "likelihood of confusion" in trademark cases.

There is no conflict between the Federal Circuit's decision and the "rationale" in *Two Pesos*. The *Two Pesos* decision has no relevance to consideration or disposition of the issues in this case. Consequently, neither Bristol-Myers, American Home Products nor INTA make a threshold showing of any issue meriting the attention of this Court.

C. None of the Circuit Court decisions cited by the proposed Amici are in conflict with the Federal Circuit's decision in this case, thus, they offer no additional support for the Petition.

The proposed Amici primarily rely upon purported conflicts between the Federal Circuit's decision and *Oral-B Laboratories, Inc. v. Mi-Lor Corp.*, 810 F.2d 20 (2d Cir. 1987) ("Oral-B") and Two Pesos.[4] The INTA also suggests vague and undefined conflicts with other Circuit Court decisions. INTA's Brief at 7. The defect in INTA's arguments is a fundamental misunderstanding about the concept of a conflict between Circuits.

Certiorari is appropriate where a real or intolerable conflict on the same matter of law exists. *See, e.g., Two Pesos*, 120 L.Ed.2d

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[3] SmithKline Beecham is the result of a merger of SmithKline Beckman Corporation and the Beecham Group. *See* SmithKline Beecham, 1989 Annual Report (1990).

[4] Respondents Ansehl and Kessler have addressed the purported conflict with *Oral-B* in their Brief in Opposition to Conopco's Petition and will not repeat their arguments here. *See* Ansehl and Kessler's Brief in Opposition at 9-10.

at 623 ("We granted certiorari to resolve the conflict among the Courts of Appeals on the question whether trade dress which is inherently distinctive is protectable under § 43(a) without a showing that it has acquired secondary meaning") (footnote omitted); *Qualitex Co. v. Jacobson Products Co.*, No. 93-1577, 1995 WL 128239 (U.S. Mar. 28, 1995) ("The courts of appeals have differed as to whether or not the law recognizes the use of color alone as a trademark. . . . Therefore, this Court granted certiorari.")

Rule 10 of the Supreme Court Rules provides that certiorari is appropriate when a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter. "This means that there must be a real or 'intolerable' conflict on the same matter of law or fact, not merely an inconsistency in dicta or in the general principles utilized." Robert L. Stern et al., *Supreme Court Practice* § 4.3 at 167 (7th Ed. 1993). *See also Wisconsin Electric Co. v. Dumore Co.*, 282 U.S. 813 (1931) (certiorari was improvidently granted because the purported conflict arose from differences of fact and not principles of law).

The conflicts that merited a grant of certiorari in *Two Pesos* and *Qualitex* were real conflicts in the principles of law applied in the Circuit Courts of Appeals, i.e. direct conflicts in the holdings of the courts. The INTA could not identify any such conflicts in its brief and did not attempt to do so. None of the cases cited by the INTA involved the trial court's failure to consider the dominance of the defendant's mark in the context of the sale of defendant's products or the absence of confusion despite a history of competition. All of the cases cited by the INTA are distinguishable on their facts. *Paddington Corp. v. Attiki Importers & Distrib.*, 996 F.2d 577, 586 (2d Cir. 1993) (the two supposedly distinct marks were "#1" vs. "No.12" -- a distinction that the court noted "disappears if one takes a few steps back"); *Nabisco Brands Inc. v. Conusa Corp.*, 722 F. Supp. 1287, 1291, 1293 (M.D.N.C. 1989), *aff'd*, 14 U.S.P.Q.2d 1324 (4th Cir. 1989) (the court granted preliminary injunctive relief

based upon infringement of the LifeSaver trademark and noted the identical size and shape of the candies, the "difficulty of distinguishing the embossed words on the candies" and that "even at close range the lettering is hard to detect"); *Badger Meter Inc. v. Grinnel Corp.*, 13 F.3d 1145, 1153 (7th Cir. 1994) (the plaintiff presented ample evidence of actual confusion); *Charles Jacquin Et Cie v. Destileria Serralles*, 921 F.2d 467 (3d Cir. 1990) (the court never even addressed the trademarks or logos of the competing bottles). None of the decisions cited by INTA present any conflict with the Federal Circuit's decision in this case. All are irrelevant to this Court's decision to grant or deny certiorari.

D. The proposed Amici's theories of confusion are a red herring, irrelevant to the issues before this Court.

The proposed Amici also miss the mark on the issue of actual confusion. The Federal Circuit overturned as clearly erroneous the trial court's determination that there was actual confusion. Wisely, Conopco didn't challenge the Federal Circuit's decision on this point for two reasons. First, the only evidence which Conopco offered to show "actual confusion" was the testimony of one witness, Mrs. Sickles, who bought one bottle of lotion from a Target (not Venture) store believing the lotion to be manufactured by Conopco. Its evidence of actual confusion was an infinitesimal fraction of 1% of Conopco's sales.[5] Conopco chose not to conduct a confusion study.[6] Secondly, there is a wealth of authority that isolated instances of confusion do not support a finding of actual confusion. *See Harad v. Sears, Roebuck & Co.*, 204 F.2d 14, 19 (7th Cir.), *cert. denied*, 346 U.S 914 (1953); *see also Woodsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244, 1249 (8th Cir. 1990); *Amstar Corp. v.*

[5] Conopco annual sales of VICL are in excess of $100,000,000.

[6] The failure to conduct a confusion study is also telling. *See Charles Jacquin Et Cie. v. Destileria Serralles*, 921 F.2d 467, 475 (3d Cir. 1990).

Domino's Pizza, Inc., 615 F.2d 252, 263 (5th Cir. 1980), *cert. denied*, 449 U.S. 899 (1980).

The INTA, Bristol-Myers and American Home Products argue that the Federal Circuit failed to consider Conopco's evidence as "sponsorship", "association" or "foot in the door" confusion. INTA's Brief at 10-11; Bristol-Myers' Brief at 8-15; American Home Products' Brief at 8-13. It doesn't matter what *kind* of confusion best describes Mrs. Sickles testimony. The fact remains that one isolated instance of confusion is not enough to support a finding of actual confusion. Consequently, Amici's theoretical arguments about different kinds of consumer confusion are entirely irrelevant to this Court's consideration of the issue. Their Motions should be denied.

E. Conclusion.

The proposed Amici have offered no facts or quesitons of law not adequately presented by the parties. Nor have they demonstrated the relevance of the authorities upon which they rely to the disposition of the specific issues before this Court. They have failed to demonstrate any conflict between the holding of the Federal Circuit and any other authority. The proposed Amici have presented nothing that will assist this Court in determining whether certiorari is appropriate.

Respondents Ansehl and Kessler respectfully request that this Court deny the Motions for Leave to File Brief *Amicus Curiae*.

Respectfully submitted,

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